

Docket No. C10125-US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the U.S. Application of

Andrew WATSON

Group Art Unit: 3066

U.S. Serial No.: 09/453,800

Examiner: Akers, G.

Filed: December 3, 1999

For: SYSTEMS AND METHODS FOR BUILDING A PERSONALIZED ACCOUNT

APPEAL BRIEF

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Sir:

This is an Appeal Brief under 37 C.F.R. § 1.192 in connection with the decisions of the Examiner in a Final Office Action mailed on May 16, 2002. Each of the topics required by Rule 192 is presented herewith and is labeled appropriately.

(1) **Real Party In Interest**

The real party in interest is Universal Card Services Corp.

(2) **Related Appeals And Interferences**

There are no other appeals or interferences related to this case.

(3) **Status Of Claims**

Claims 1-21 are pending and rejected. Claims 1-21 are hereby appealed.

(4) **Status of Amendments**

There are no outstanding amendments.

**(5) Summary Of The Invention**

The present invention is directed to a system and method for providing account-based services via a network site, wherein an applicant can shop for a particular credit card and select any number of services and options to be associated with the card. The present invention also provides a real-time credit check of the applicant to determine his/her credit worthiness, wherein the applicant can know immediately the eligible line of credit as well as the credit card number so that s/he can make purchases immediately after ordering the credit card. Page 5, lines 5-21. A method of the present invention includes determining the worthiness of an applicant, providing a plurality of options from which the applicant can choose to associate with an account, adjusting factors associated with the account and submitting to the applicant selected information for providing the account. Page 6, lines 17-20. Thus, the present invention provides an adjustable and dynamic medium to purchase other account-based services, such as insurance, communication services, investments, loans, and mortgages. Page 6, lines 9-12.

**(6) Issue**

a) Whether the Examiner's rejection of claims 8, 9, and 20-21 under 35 U.S.C. 112, second paragraph, is proper.

b) Whether the Examiner's rejection of claims 1-7 and 18-19 under 35 U.S.C. 102(e) as being anticipated by DeFrancesco et al. (U.S.P. No. 5,878,403) is proper.

c) Whether the Examiner's rejection of claims 11 and 12 under 35 U.S.C. 103(a) as being unpatentable over DeFrancesco et al. in view of Keen (U.S.P. No. 5,774,882) is proper.

d) Whether the Examiner's rejection of claims 10 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeFrancesco et al. in view of Buchanan (U.S.P. No. 5,950,179).

e) Whether the Examiner's rejection of claim 13 under 35 U.S.C. 103(a) as being unpatentable over DeFrancesco et al. is proper.

**(7) Grouping of Claims**

Claims 1-21 are arranged into 8 groups, wherein the claim(s) in each group stand or fall together for purposes of this appeal.

GROUP	CLAIMS
(1)	1, 13
(2)	2
(3)	3-7, 10
(4)	11, 12
(5)	14-17
(6)	18
(7)	19
(8)	8, 9, 20-21

**(8) Argument**

**The rejection of claims 8, 9, and 20-21 Under 35. U.S.C. 112 (2<sup>nd</sup> Parag.) is not proper**

Once again, the Examiner rejected claims 8, 9, and 20-21 for “failure to state by the applicant in specific detail what the invention is.” To support the rejection, the Examiner asserted the following ambiguity:

“Claims 8-9 do not delineate how the use of qualifications is employed *specifically* to develop the baseline offer, ie. what methodology or technique is employed to derive the offer. Claim 9 addressed not providing the baseline offer dependent on the qualification which is apart from claim 8. These claims are ambiguous and should be resolved and made more *specific*. Similarly claims 20-21 should *specifically* address the order of preference signals and their direct relationship with defined features, the manner of adjustment of a first modified offer to derive the second modified offer and the iterative mechanism employed to form the account based services.” Final Office Action dated 5/16/02, page 7.

As stated in a previous Response filed April 23, 2002, MPEP 2173.02 provides the following guidelines for examination under 35 U.S.C. 112, second paragraph:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, ***not whether more suitable language or modes of expression are available***. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. ***Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire***. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, ***but should not reject claims or insists on their own preferences if other modes of expression selected by the applicant satisfy statutory requirement***. (Emphasis added).

It is respectfully submitted that the language of claims 8, 9, 20, and 21 clearly and distinctly set out the claimed invention, and it meets the threshold requirements of clarity and precision. This is evident by the Examiner's clear understanding of the language of claims 8, 9, 20, 21 in the above-recited Examiner's assertion. What the Examiner deemed ambiguous is not so much the clarity and precision of the claimed subject matter, but rather the lack of specificity to the claimed subject matter because of the broadness of the claim language. According to MPEP 2173.04,

***Breadth of a claim is not to be equated with indefiniteness. In re Miller***, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. (Emphasis added).

Accordingly, while the claim language may not be as precise or the breadth of the claimed invention may not be as narrow as the examiner might desire, the examiner should not reject the claims. Hence, it is respectfully requested that the examiner withdraw the rejection of claims 8, 9, 20, and 21 under 25 U.S.C. 112, second paragraph.

**The rejection of claims 1-7, and 18-19 Under 35. U.S.C. 102(e) as being unpatentable over DeFrancesco et al. is not proper**

Regarding claim 1, the Examiner asserted that DeFrancesco et al. provide a baseline offer for a first account-based service in the Abstract. However, the Abstract merely describes a system for “selectively receiving credit application data from respective applications... and selectively forwarding funding decision data from the funding sources to the respective applicants... and for forwarding a received funding decision to the at least one remote application input and display device.” Thus, the funding decision data and funding decision are not specifically referring to “providing a *baseline offer*” as claimed. At best the funding decision can be considered an offer, not a *baseline offer* that can be adjusted in accordance with a first preference indicator signal. Furthermore, DeFrancesco et al. do not show receiving a first preference indicator signal in Fig. 1B, blocks 148, 149, 150, 152, as asserted by the examiner. Indeed, the cited blocks and accompanying text in DeFrancesco et al. describe a process whereby a credit application is forwarded to numerous funding sources for credit approval. There is no preference indicator signal but merely: 1) a decision made in block 150 as to whether the credit is approved or rejected; and 2) a decision made in block 153 as to whether the credit application should be sent to additional funding sources because the initial funding source declines or places unacceptable conditions on the credit approval. Thus, while there may be an offer from one or more funding sources or a conditional offer with unacceptable conditions disclosed by DeFrancesco, such offer is not a baseline offer that can be adjusted based on a first preference indicator signal as claimed. The Examiner pointed to col. 12, line 63 to col. 13, line 18 and col. 13, line 58 to col. 14, line 3 as evidence that DeFrancesco et al. disclose a baseline offer that can be modified based on options. Final Office Action dated 5/16/02. However, the cited sections merely show the ability of a dealer to modify and resubmit a credit application in order to obtain another offer, not a baseline offer that can be modified based on a preference indicated signal as claimed.

Regarding claim 2, it is allowable for the reasons stated above with regard to the allowability of claim 1. Furthermore, as stated above, the decision made in block 153 as to

whether the credit application should be sent to additional funding sources cannot be a preference indicator signal, much less a second preference indicator signal as claimed. Thus, it cannot be used to adjust the first modified offer so as to form a second modified offer as claimed. This is because the decision block 153 does not modify any offer and merely refers the credit application back to select other funding sources for *other* approval offers.

Regarding claims 3-7, the examiner cited various sections of DeFrancesco et al. against the claimed features of providing a list of available preference indicator choices along with providing the baseline offer. However, the cited sections describe different features, so they cannot be deemed to refer to the same features as claimed. Specifically, col. 22, lines 39-41 describes the flexibility in funding source selection, and routing (there is no mentioning of providing preference indicator choices as claimed); col. 23, lines 48-50 indicates that at block 152 of Fig. 1B, the dealer can review a display of the status of the credit application, e.g., granted, granted with conditions, or declined and reasons why declined (thus, there are *numerous offers*, not available preference indicator choices provided along with a *single baseline offer* as claimed, that the dealer can review); and col. 24, lines 1-5 indicates that at block 153 of Fig. 1B, a decision is made whether the credit application should be sent to additional funding sources (again, there is no mentioning of providing preference indicator choices).

Regarding claim 18, it is allowable for the reasons stated above with regard to the allowability of claim 1. Furthermore, DeFrancesco et al. fail to disclose providing a list of available features with associated first preference indicator signal as claimed. The Examiner asserted that this claimed limitation is found in DeFrancesco et al. at col. 10 line 38 to col. 11, line 56. However, the cited sections merely show that multiple funding sources may be set up to handle different types of credit applications, not a list of available features that can be used to modify an existing baseline offer.

Regarding claim 19, it is allowable for the reasons stated above with regard to the allowability of claim 18. Furthermore, as stated above, the decision made in block 153 as to whether the credit application should be sent to additional funding sources cannot be a

preference indicator signal, much less a second preference indicator signal as claimed. Thus, it cannot be used to adjust the first modified offer so as to form a second modified offer as claimed. This is because the decision block 153 does not modify any offer and merely refers the credit application back to select other funding sources for *other* approval offers.

**The Rejection of claims 11 and 12 under 35 U.S.C. 103(a) as being unpatentable over DeFrancesco et al. in view of Keen (U.S.P. No. 5,774,882) is not proper**

Regarding claims 11 and 12, they are allowable for the reasons stated above with regard to the allowability of claim 1. Furthermore, DeFrancesco et al. and Keen et al. do not disclose that the account based services relate to an insurance account. Therefore, there is no basis for the examiner to state the motivation to combine the two references is “as enunciated by Keen [et al.]” when such alleged motivation is at best directed to account based services relating to a credit card account and not to an insurance account.

**The Rejection of Claims 10 and 14-17 under 35 U.S.C. 103(a) as being unpatentable over DeFrancesco et al. in view of Buchanan (U.S.P. No. 5,950,179) is not proper**

Regarding claim 10, it is allowable for the reasons stated above with regard to the allowability of claim 3.

Regarding claims 14-17, it is unclear from the rejection how the features of Buchanan et al. can be combined with those of DeFrancesco et al. and the motivation behind such combination to disclose the claimed subject matter. Indeed, the Examiner’s cited element 84 in FIG. 2 of Buchanan et al. denotes a credit card account processor and not an account services building module for receiving preference indicator signals indicative of features associated with an account-based service as claimed.

**The Rejection of claim 13 under 35 U.S.C. 103(a) as being unpatentable over  
DeFrancesco et al. is not proper**

Regarding claim 13, it is allowable for the reasons stated above with regard to the allowability of claim 1.

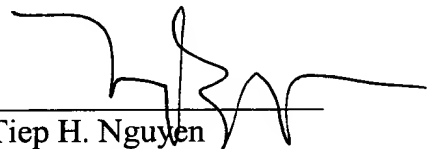
**Conclusion**

For at least the reasons given above, the rejection of claims 1-21 is improper. It is respectfully requested that such rejections by the Examiner be reversed and claims 1-21 be allowed. Attached below for the Board's convenience is an Appendix of claims 1-21 as currently pending.

Respectfully submitted,

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**(9) Appendix**

1. A method of offering account based services comprising:  
providing a baseline offer for a first account based service;  
receiving a first preference indicator signal; *(Pre-approval)*  
adjusting the baseline offer so as to form a first modified offer based upon the first preference indicator signal;  
adjusting the first account based service so as to form a second account based service based upon the first preference indicator signal; and  
providing the first modified offer for the second account based service.
2. The method of claim 1 further comprising:  
receiving a second preference indicator signal;  
adjusting the first modified offer so as to form a second modified offer based upon the second preference indicator signal;  
adjusting the second account based service so as to form a third account based service based upon the second preference indicator signal; and  
providing the second modified offer for the third account based service.
3. The method of claim 1 further comprising:  
providing a list of available preference indicator choices along with providing the baseline offer.
4. The method of claim 1 further comprising:  
providing a list of available preference indicator choices along with providing the first modified offer.
5. The method of claim 3 further comprising:

selecting the list of available preference indicator choices from a universe of possible preference indicators.

6. The method of claim 3 further comprising:  
receiving personal information; and  
determining a qualification based on the personal information.
7. The method of claim 6 further comprising:  
using the qualification to select the list of available preference indicator choices from the universe of all possible preference indicator choices.
8. The method of claim 6 further comprising:  
using the qualification to form the baseline offer.
9. The method of claim 6 further comprising not providing the baseline offer dependent upon the qualification.
10. The method of claim 6 wherein the qualification is a credit line.
11. The method of claim 1 wherein the first and second account based services relate to a credit card account.
12. The method of claim 1 wherein the first and second account based services relate to an insurance account.
13. The method of claim 1 wherein the first and second account based services relate to a telecommunications account.

14. A computer system comprising a first computer wherein the first computer comprises:

- a firewall module for determining security parameters;
- an applicant module for collecting data;
- a checker module for determining worthiness parameters; and
- an account services building module for receiving preference indicator signals indicative of features associated with an account-based service.

15. The computer system of claim 14 further comprising a network coupled to the first computer.

16. The computer system of claim 15 further comprising a second computer coupled to the network.

17. The computer system of claim 15 wherein the network includes the World Wide Web.

18. A method of offering account based services comprising:

- providing a baseline offer for a first account based service;
- providing a list of available features;
- receiving a first preference indicator signal associated with a first feature from the available features;
- adjusting the baseline offer so as to form a first modified offer based upon the first preference indicator signal;
- adjusting the first account based service so as to form a second account based service by combining the first feature onto the first account based service so as to form the second account based service; and
- providing the first modified offer for the second account based service.

19. The method of claim 18 further comprising:  
receiving a second preference indicator signal associated with a second feature from the available features ;  
adjusting the first modified offer so as to form a second modified offer based upon the second preference indicator signal;  
adjusting the second account based service so as to form a third account based service by combining the second feature onto the second account based service so as to form the third account based service; and  
providing the second modified offer for the third account based service.

20. The method of claim 18 further comprising:  
receiving a second preference indicator signal associated with a second feature from the available features ;  
adjusting the first modified offer so as to form a second modified offer based upon the second preference indicator signal;  
adjusting the second account based service so as to form a third account based service by deleting the first feature from the second account based service and by combining the second feature onto the second account based service so as to form the third account based service; and  
providing the second modified offer for the third account based service.

21. The method of claim 18 wherein the adjusting of the first account based service so as to form a second account based service further comprises:  
combining a second feature onto the first account based service so as to form the second account based service.